Amendments to the Drawings:

The attached sheet of drawings include changes to Figure 2D. This sheet replaces the original sheet.

Attachment

Remarks/Arguments:

By way of the foregoing, the specification has been amended so that the language in the specification conforms with the language in claims 22-25. Claim 26 has been cancelled to avoid distraction and, thus, expedite the prosecution of this application. The subject matter of claim 26 will be presented in Applicants' co-pending application, Serial No. 11/405,187.

In view of these amendments and the following Remarks, it is submitted that this application is in condition for allowance. Reconsideration and allowance are respectfully requested. Alternatively, entry of this amendment is requested because it materially reduces the issues for appeal.

With respect to the rejections of claims 22-25 under 35 U.S.C. 112, the amendment to the specification incorporates the language from claim 22 to describe the rotatable flange with the same language.

It is submitted that the amendment to the specification obviates the rejection under 35 U.S.C. 112 and that it does not include new matter as prohibited under 35 U.S.C. 132(a).

Addressing the Examiner's comment that "There is no support within the originally filed specification, for the claim limitation that, "the flange can rotate freely after assembly', Applicants' note that the claims were not rejected under 35 U.S.C. 132(a), so there is no question that the rejected claims contain prohibited new matter. Applicants' original disclosure supported the claims as they now appear, but Applicants' will, for the sake of completeness, point out the support in the original disclosure.

The application, as originally filed, shows in the drawing, describes in the specification and recites in the claims a "valve assembly" and, in particular, "an isolation valve assembly" having a "rotatable flange'". That is, this application discloses and claims a fully assembled combination of elements including a valve 98, insert 102 and rotatable flange 106. For example, paragraph 24, as originally filed, stated "This valve assembly includes a valve 98, insert 102, and rotatable flange106". After these three parts are fitted together the valve assembly is formed and when the assembly is formed, the flange is rotatable.

Applicants' refer to the ordinary dictionary definition of the word "assembly". In Merriam-Webster's Collegiate Dictionary, Eleventh Edition (First Printing 2003), the definition of the word "assembly" includes "6a: the fitting together of manufactured parts into a complete machine, structure or unit of a machine b: a collection of parts so assembled". In Random House Webster's Unabridged Dictionary, Second Edition, copyrighted 1998, 1996,

1993 and 1987, the definition of the word "assembly" includes "6. Mach. A group of machine parts, esp. one forming a self-contained independently mounted unit". In McGraw Hill Dictionary of Scientific and Technical Terms, Fifth Edition, copyrighted 1994, 1989, 1984, 1978, 1976 and 1974, the definition of the word "assembly" includes "[MechEng] A unit containing the component parts of a mechanism, machine, or similar device".

From the ordinary, dictionary definition of the word "assembly" it is clear that this application, as originally filed, disclosed (1) a collection of parts (valve 98 and its valve body 100, insert 102 and rotatable flange 106) fitted together to form a complete structure (the valve assembly disclosed in Figs. 1A and 1B of the drawing), (2) a self-contained unit or (3) a unit containing the component parts of a mechanism. The application as originally filed disclosed a complete "valve assembly" and, more particularly, a complete "isolation valve assembly" ready for use or installation into a hydronic system. In this complete assembly, the original disclosure made clear that the flange is rotatable. Thus, the disclosure, as originally filed, clearly discloses that the flange is rotatable when the insert is assembled to the valve housing.

In view of the foregoing, it is submitted that the amendment of the specification answers the rejection under 35 U.S.C. 112, that no new matter has been added and that this rejection should be withdrawn.

Turning now to the rejections over 35 U.S.C. 102 and 103, Applicants' point out that the Rocheleau publication must include a clear, enabling disclosure of Applicants' claims if Rocheleau is to anticipate Applicants' claims. See Abbott Laboratories v. Diamedix Corp., 969 F.Supp. 1064, 43 USPQ2d 1448 (N.D. Ill. 1997). The Court held:

> "For a patent to be anticipated by a printed reference, the reference must describe the patented invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. In re Spala, 911 F2d at 708....it need only describe enough information to allow one of ordinary skill in the art to make the invention work." (43 USPQ2d at 1452)

Rocheleau does not place a person of ordinary skill in the art in possession of Applicants' invention, that is, of a valve assembly with a rotatable flange as recited in the claims.

Applicant's again point out that the Rocheleau publication does not disclose a valve assembly wherein a flange is rotatable after the assembly is complete. For all of the reasons

noted in Applicant's amendment filed on June 5, 2006 (incorporated here), it is again pointed out that the Racheleau flange element 28 is rotatable before the valve assembly is an assembly. In the Rocheleau publication, the flange element is rotatable and adjustable while the parts of the valve assembly are being fitted together to form the valve assembly. After fitting the Rocheleau component parts together, the flange element 28 is not rotatable or adjustable. In Fig. 6 of the drawing it is clear that the flange element 28 is clamped in place by the by threading member 16 and valve body 10.

The final rejection refers to Rocheleau's specification at Col. 2, lines 5-7 to support a conclusion that " the flange" is "freely rotatable relative to the insert and the valve housing when the insert is assembled to the valve housing". This conclusion is not supported when the Rocheleau disclosure is taken as a whole.

The Rocheleau publication, as with any prior art reference, must be read as a whole to determine the subject matter disclosed. That means that column 2, lines 5-7 must be read in context and the meaning of lines 5-7 must be determined with a reading of the immediately preceding sentence and, in particular, the clause appearing at col. 2, lines 1-4. In lines 1-4, the Rocheleau publication discloses that the "installer needs to install only one item" when "making a connection to a hydronic circulator". Thus, the installer referenced in lines 5-7 is selecting a preferred orientation of the flange when fitting together the components that will form the valve assembly. Taken in context, the Rocheleau publication makes clear that installation and assembly are two different procedures. Installation is limited to "making a connection to a hydronic circulator" and "assembly" is limited to fitting the component parts to form the valve assembly. The rotation of the flange "may be allowed" when fitting parts together, but there is no disclosure that rotation is allowed after the assembly is completed. Nor is there any disclosure that the flange is rotatable during installation of the assembly to a hydronic circulator. It is submitted that Rocheleau's disclosure at column 2, lines 5-7 does not support a conclusion that the flange element 28 is rotatable after the assembly is complete.

Continuing a reading of the Rocheleau publication in its entirety, reference is now made to column 3, lines 12-22. Rocheleau again makes clear that the flange element is rotatable before the component parts are fitted together, but does not support the conclusion that the flange element is rotatable after the parts are fit together, that is in the valve assembly. Rocheleau's choice of words is not consistent with the words used in column 2, lines 1-7. In column 3 Rocheleau has transposed the meaning of installation and uses the words "installed" and "installation" to mean that the component parts are being fitted together to form an

assembly. In column 3, lines 12-14, Rocheleau explains that the "flange element 28 is installed by threading member 16 (brass) into female threads 17 in valve body 10". Here Rocheleau is clearly making reference to the procedure for fitting parts together to form the valve assembly. In that same paragraph, at column 3, lines 18-22, Rocheleau explains that, "During installation of the ball valve, the relative angular orientation of the flange element 28 and the valve body 10 can be adjusted." From the context, that is from lines 12-14 it is clear that the relative angular orientation is adjusted when the component parts are being fit together, not when the assembly is complete.

From the foregoing it is clear that Rocheleau's flange element 28 is rotatable when the valve assembly is being fit together. Once the Rocheleau valve assembly is formed, the drawings make clear that the flange is clamped in place and cannot be rotated.

Claims 21-25 and 27 clearly recite a valve assembly including a rotatable flange. In these claims a valve assembly is claimed, an assembled group of parts, that includes, after assembly, a rotatable flange. Claims 21-25 take it a step further and drive home the point that the flange is freely rotatable when the insert is assembled to the valve housing. Rocheleau does not disclose such an arrangement and the rejection under 35 U.S.C. 102 is improper and should be withdrawn.

From the above analysis of the Rocheleau publication, it is clear that Rocheleau does not place a person of ordinary skill in the art in possession of Applicants' invention, that is, of a valve assembly with a rotatable flange as recited in the claims.

Applicants' also point out that the above analysis shifts the burden of proof to the USPTO to show that the Rocheleau publication does, in fact, place a person of ordinary skill in the art in possession of Applicants' invention, that is, a valve assembly with a rotatable flange as recited in the claims. See In re Sasse, 629 F2d 675, 207 USPQ 107 (C.C.P.A. 1980) for a discussion of the shifting burden of proof between the USPTO and the patent applicant.

The Rocheleau publication is not an issued patent having a presumption of validity including a presumption that the disclosure is enabling. The Rocheleau disclosure has been shown to not have an enabling disclosure. It does not place a valve assembly with a rotatable flange in the possession of one skilled in the art. The USPTO must now show that it does so or this application should be allowed.

Claims 28 and 29 are allowable for the same reasons set forth with respect to their parent claim 27. Adding the Keller III patent does not address the deficiencies of the Rocheleau publication.

Moreover, the Keller III patent does not include any disclosure that supports a conclusion that the insert configurations recited in claims 28 and 29 would be obvious to one skilled in the art. Claims 28 and 29 recite that the free end of the insert accommodates a tool for threadably coupling the insert to the valve body. In contrast, Keller III discloses an adjustable valve where water pressure closes the valve without dependence on manual actuation. See column 1, lines 15-18. The valve stem 17 includes a hexagonal bottom section 21 that accommodates a hex wrench to effect adjustment of the valves closing point. Keller III does not disclose anything remotely like the claimed insert, it does not disclose using a hexagonal section to couple anything together. Moreover, the hexagonal section 21 in the Keller III patent is not located at the free end of a flow channel nor at the free end of anything to couple anything together. The hexagonal section 21 is located at the bottom of the valve stem, not adjacent its free end. It cannot render the subject matter of claims 28 and 29 obvious - it is lacking any relevant teaching and there is no motivation to combine the Keller III valve stem with Applicants' insert.

As noted, reconsideration and allowance of this application are requested or in the alternative entry of this amendment is requested for purposes of appeal.

Respectfully submitted,

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RPS/dhm
Encls.: 1 drawing sheet

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November 15, 2006